



THE UNITED STATES PATENT AND TRADEMARK OFFICE

AFFIDAVIT UNDER 37 CFR §1.131

REISSUE SERIAL NO. : 09/592,461
FILING DATE : June 6, 2000
GROUP ART UNIT : 2641
EXAMINER : T. Smits
INVENTORS : Novosel et al.
TITLE : "SOUND RECORDING AND REPRODUCTION SYSTEM
FOR MODEL TRAIN USING INTEGRATED DIGITAL
COMMAND CONTROL"

Asst. Commissioner for Patents
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Applicants provide the following as evidence of conception of the invention and due diligence in reducing the invention to practice prior to October 1996.

The present invention was first conceived in September 1994. The attached letters between the inventors and between the inventors and their attorney of record as well as the attached advertisement and review are provided as evidence of conception and due diligence in reducing the invention to practice.

A dual sound module which required no additional decoder, bell and whistle or horn was outlined in paragraph four of a letter from Mike Novosel to Kelly Boles dated November 6, 1994 (see item a of Appendix A). Further, sound effects in physical memory was

outlined in the fourth paragraph of a letter from Mike Novosel to Kelly Boles dated circa November 12, 1994 (see item b of Appendix A).

An advertisement for a Digital Command Control compatible dual sound module was published in the *Model Railroader* magazine issue dated February 1995. The advertisement stated the sound module included "moos, oinks, nays, bass, elephant trumpets, tiger growls, and train sounds" and stated the sound module was due for release in mid winter, 1995. (See page 161 of *Model Railroader* February 1995, item c of Appendix A).

The Digital Command Control sound system advertised in the above noted advertisement was reviewed in the October 1995 issue of *Model Railroading* (See item d of Appendix A). More specifically, the article stated "the Real Rail Effects Prime Mover Phase II Sound Module . . . provides three basic sounds - bell, whistle/horn and diesel or steam engine sounds. . . . control Prime Mover using any of the 63 possible addresses." Id. The sound system described in the *Model Railroading* article described the sounds as very good because they are digital recordings of the real thing but stated "the chip can only play back one sound at a time." (See second paragraph, page 39, *Model Railroading*, October 1995.)

In addition to the magazine advertisements and reviews cited herein, a letter describing features of the present invention, dated October 6, 1994, (see item e of Appendix A), was sent to the

attorney of record for Applicants. More specifically, the letter dated October 6, 1994 to Applicants' attorney described a model train sound system including "a circuit to rectify and regulate power... a means to store audio data, play the information, and expand dynamic range of the data....[t]he use of a micro-controller to access and trigger the sounds....[a] means to synchronize the sounds to the speed of the train." Further, the letter to Applicants' attorney sets forth a sound system having the ability to interchange sound system components of other brands, utilizing multiple chip dies each containing separate sound library, directly mounted to a PC board.... and a sound system that will fit most popular model train size gauges. Applicants respectfully submit that the conception of the invention clearly predates SoundTraxx. Applicants further submit that they acted with due diligence as evidenced by their communications with their patent attorney of record.

Further, development log entries in the form of letters, personnel references, and email between co-inventors, Michael J. Novosel and Kelly Boles show prior conception of the invention prior to October 1996 and due diligence in reducing the invention to practice.

(a.) In a letter to Kelly Boles dated September 5, 1994, Kelly Boles's assistance in designing a command control sound system with the ability to integrate with various methods of train

control is requested. (See item f of Appendix A.) Creating a synchronized sound system that would contain various sound effects found on a real locomotive was also outlined as a design goal.

(b.) In a letter to Michael Novosel from Kelly Boles dated September 22, 1994, a DCC decoder to control a sound board is described. (See item g Appendix A.)

(c.) In a letter to Mike Novosel from Kelly Boles dated October 5, 1994, outlining the analysis of the operation, programming and data output of a system are described. (See item h of Appendix A.)

(d.) In a letter to Mike Novosel from Kelly Boles dated October 14, 1994, Applicants describe a design issue pertaining to the EOM marker set by the ISD system. (See item i of Appendix A.)

(e.) In a letter to Mike Novosel from Kelly Boles dated October 31, 1994 (see item j of Appendix A), Applicants discussed a preliminary design based on two sounds disclosed on page 161 in the February 1995 issue of *Model Railroader*. (See item c of Appendix A.)

(f.) In letters to Mike Novosel from Kelly Boles dated January 3, 1995 and January 17, 1995, Applicants detailed automatic activation of sound effects. (See item k of Appendix A.)

Further, a letter to Kelly Boles from Mike Novosel, sent in January 1995, demonstrates motor control defined in Claim 1 of the present invention. Specifically, the motor drive circuitry programmable motor noise snubbing, external sound synchronization and programmable sound and motor control variables are described. More specifically, in the third paragraph, Mike Novosel wrote "due to the fact that some one will want to activate both sounds at once." Further, in the fourth paragraph, Mike Novosel wrote "[a]ctivation of the three sounds could be accomplished by using...." (See item l of Appendix A.) The letter was not dated; however, the claimed date of the letter is corroborated by a copy of a Real Rail Effects, Inc. check that was referenced in the letter and attached thereto for payment of costs associated with building the dual tone sound board.

In addition to the above-identified letters, Applicants submit a record of the invention of the present invention dated September 23, 1994 and sent to their attorney of record showing invention prior to SoundTraxx. (See item m of Appendix A.)

Further, Applicants submit that they continued to diligently work on their invention as evidenced by the letter to their attorney of record dated October 6, 1994 (discussed supra). (See item e of Appendix A.) In addition to the letter, another record of invention dated August 4, 1995 was sent to their attorney of

record detailing further development on the DCC sound system. (See item n of Appendix A.)

Based on the foregoing, Applicants submit that the present invention was conceived on or before September, 1994 and that Applicants acted with due diligence to reduce their invention to practice with conception occurring prior to the effective date of the reference and coupled with due diligence from prior to the effective date to a subsequent reduction to practice and/or to the filing of the application. Accordingly, the rejection of the claims based on the SoundTraxx reference should be withdrawn. Notice to that effect is requested.